

REMARKS

Amendments to the Claims

As indicated above and consistent with the Examiner's statement with respect to allowable subject matter in the Office Action of May 29, 2008, Applicants have amended the claims to direct coverage in this application to a preferred embodiment of the invention wherein the claimed process for isolating nucleic acids employs a non-siliceous membrane that has pores that have a diameter from 1 μm to 50 μm . Accordingly, Claims 1, 51, 90, and 91, as amended herein, expressly recite "1 μm " as a minimum pore diameter. In particular, Claims 1 and 51, as amended herein, expressly state that the membrane employed in the process has pores that have a diameter from 1 μm to 50 μm . Claim 90, as amended herein, is directed to the process of Claim 1, wherein the membrane has pores that range from 1 μm to 20 μm in diameter. Claim 91, as amended herein, is directed to the process of Claim 1, wherein the membrane has pores that range from 1 μm to 10 μm .

Applicants have also amended step (3) of Claim 51 to replace the term "waste" (as in "waste" side of said membrane) with the term "said other" (side of said membrane), as recited in the preceding step (b) of the claim. Accordingly, the amendment maintains internal consistency in the use of terms in the claim and adds no new matter.

Claims 92-94, which stated a minimum pore diameters less than 1 μm , have been canceled. Accordingly, the amendments add no new matter.

Applicants take this opportunity to note that cancellation of any claim in this application should not be interpreted as an abandonment of the subject matter of such canceled claim or of any subject matter described in the specification. Applicants reserve the right to pursue coverage for the subject matter of any canceled claim(s) or for any subject matter described in the specification in a continuation or divisional application.

Applicants have also amended withdrawn Claim 6, and thereby withdrawn Claim 7 as well, to delete recitation of Claim 2, which was previously canceled.

Applicants have also amended withdrawn Claim 8 to replace the term "surfaces" with the term "membranes" in accordance with the amendment of Claim 1 to replace the term "surface" with the term "membrane" made in Applicants' Response of June 9, 2006.

Entry of the amendments is respectfully requested.

Amended Claims Overcome Rejections Under 37 CFR §§ 102 and 103

In the Office Action, dated May 29, 2008, the Examiner stated that Claims 95-100 would be allowable if rewritten in independent form since the prior art does not teach use of filters with large pore sizes in the claimed ranges to isolate nucleic acids. Claims 95-100 are directed to the process for isolating nucleic acids according to Claim 1, wherein the membrane has pores that have a diameter of at least 1 μm (Claim 95), at least 1.2 μm (Claim 96), at least 3 μm (Claim 97), at least 5 μm (Claim 98), at least 10 μm (Claim 99), and at least 20 μm (Claim 100). However, Claim 1 previously recited a process for isolating nucleic acids comprising a non-siliceous membrane that has pores that have a diameter of 0.001 μm to 50 μm , and, therefore, recited a process employing a membrane having a pore diameter smaller than that of a process deemed allowable by the Examiner.

In accordance with the Examiner's statement of allowable subject matter, Applicants have now amended independent Claims 1 and 51 to recite a process wherein the membrane has pores that have a diameter of 1 μm to 50 μm . Claims 90 and 91 have been similarly amended to recite a minimum pore diameter of 1 μm in the recited pore diameter range for the membrane. Claims 92-94, which recited pore diameters less than 1 μm have been canceled. Claims 95-100, which depend from Claim 1, as amended herein, are therefore also allowable in dependent form.

Applicants respectfully submit that the amendments to the claims overcome the rejections in the Office Action of claims under 35 USC § 102 as anticipated by Ogawa (EP 0 431 905) and the rejections of claims under 35 USC § 103(a) as being obvious over Ogawa in combination with Mullis (US 5,234,824) or over Ogawa in combination with Mullis, Pfister (*J. Biol. Chem.*, 271(3): 1687-1694 (1996), Boom (US 5,234,809), Colpan (US 6,383,393), and MacFarlane (US 5,985,572). Accordingly, in view of the amendments to the claims, reconsideration and withdrawal of the rejections are respectfully requested.

Request for Rejoinder of Previously Withdrawn Claims

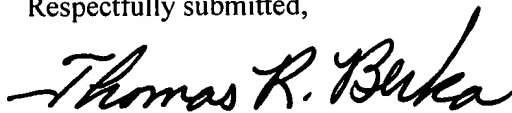
The claims, as amended herein, are now directed to an allowable process for isolating nucleic acids. Since the claimed process is allowable irrespective of the means for carrying out the process, Applicants respectfully request that the Examiner rejoin formerly withdrawn Claims 6, 7, and 8, as amended herein, which are linked by Claim 1, as amended herein.

Conclusion

Applicants have amended the claims to direct coverage in this application to a process that is consistent with the subject matter deemed allowable by the Examiner in the Office Action of May 29, 2008. Moreover, formerly withdrawn Claims 6-8, as amended herein, are now linked by dependency

from Claim 1, which Applicants have amended to cover an allowable process. Accordingly, in view of the amendments and all of the comments in this record, Applicants submit that the rejections have now been overcome. The Examiner is therefore respectfully requested to enter the amendments; to pass Claims 1, 3-5, 9-17, 22, 24-31, 33-40, 51, 53-55, 59-64, 69-74, 76-81, 83-91, and 95-100, as amended herein, to allowance; and to rejoin Claims 6, 7, and 8, as amended herein, to the group of allowed claims.

Respectfully submitted,



Thomas R. Berka, Ph.D., Reg. No. 39,606
Leon R. Yankwich, Reg. No. 30,237
Attorneys for Applicants
Yankwich & Associates, P.C.
201 Broadway
Cambridge, Massachusetts 02139
Telephone: (617) 374-3700
Facsimile: (617) 374-0055

CERTIFICATE OF "EXPRESS MAIL" TRANSMISSION

The undersigned hereby certifies that this correspondence and accompanying documents are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10, postage prepaid, in an envelope addressed to: **Mail Stop RCE**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Express Mail Label No. EV 509622805 US

November 28, 2008

Date



Thomas R. Berka